## REMARKS / ARGUMENTS

***Remaining Claims***

Fourteen (14) claims (Claims 1, 3, 6-12 and 15–19) remain pending in this application. Applicants have amended claims 1, 3 and 12 and have cancelled claims 2, 4, 5, 13 and 14.

***Rejection of Claims 1,2,5,6,11,12,15,16,22,23,and 25 under 35 USC §102(b)***

Claims 1, 2, 5, 6, 11, 12, 15, 16, 22, 23 and 25 were rejected by the Examiner as being anticipated by PCT Publication WO 99/20455. In order for a claim to be anticipated, each and every element claimed must be found in the prior art.

With regards to Claims 1, 12, and 23, these claims have been amended and hence, Applicants requests that these claims be reconsidered and allowed. Claim 5 has been cancelled. With respect to dependent claims 11, 15, 16, 22, and 26, the base claim has been amended and Applicants also request that these claims be reconsidered and allowed in light of the amendments made to the base claim.

***Rejection of Claims 3, 4, 7-10, 13, 14, 17-21, and 24 under 35 USC §103(a)***

Claims 3, 4, -10, 13, 14, 17-21 and 24 were rejected under 35 U.S.C. 103 (a) as being unpatentable over PCT Publication WO 99/20455. Claims 4, 13, and 14 have been cancelled.

MPEP 2143.01 provides:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggested the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The standard set forth in the MPEP has not been followed in the instant case. The Examiner has failed to provide more than one reference and admits that the cited reference does not include the resultant combination "PCT -455 discloses the basic claimed molding system ...the applied reference **essentially lacking** the aspects of the mold being made of a cyclic olefin polymer, that the collar comprises a polymeric material impregnated with carbon black, the exact ring thickness for the collar and that the molds contain a UV absorber." (Emphasis added) The Examiner also states that "these aspects are conventional in the art and would have been obvious modifications or additions to the system. Such analysis is improper.

In *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) the court concluded that the Board "reversibly erred in determining that one of [ordinary]skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention[to have been] obvious." *Id.* at 1357, 47 USPQ2d at 1457. The court noted that to

"prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." *Id.*

The modification suggested by the Examiner uses hindsight, which is improper. The Examiner is required to show a motivation to combine. For this reason, Applicants respectfully request that the rejections made to claim 1 be reconsidered and withdrawn.

## CONCLUSION

In view of the foregoing and in conclusion, Applicants submit that the 35 USC § 102 and 103 rejections set-forth in the Office Action have been overcome, and that the pending claims are not anticipated by or obvious over the cited art, either individually or in combination. Applicants request reconsideration and withdrawal of the rejection(s) set-forth in the Office Action.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Robert Gorman, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,

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